

**Notice of Allowability**

Application No.

10/092,920

Examiner

Janis L. Dote

Applicant(s)

YAMASHITA ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/12/05.
2. ☒ The allowed claim(s) is/are 1,2,4-11,29 and 30.
3. ☒ The drawings filed on 08 March 2004 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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1. This office action is responsive to the amendment filed on Apr. 12, 2005, which has been entered. The examiner acknowledges the amendment to claim 1 and the cancellation of claims 3 and 31, set forth in the amendment filed on Apr. 12, 2005.

**EXAMINER'S AMENDMENT**

2. An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on May 3, 2005, Mr. Harris Pitlick (Reg. No. 38,779) requested an extension of time for THREE MONTH(S) and authorized the Director to charge Deposit Account No. 15-0030 the required fee of \$570.00 for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Cancel claims 12-28.

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3. The examiner's amendment set forth in paragraph 2 above cancels claims to an invention non-elected with traverse in the reply filed on Jan. 9, 2004.

#### **REASONS FOR ALLOWANCE**

4. The following is an examiner's statement of reasons for allowance:

The objection to the specification set forth in the office action mailed on Nov. 17, 2004, paragraph 6, has been withdrawn in response to the amended paragraphs filed on Apr. 12, 2005, beginning at page 24, line 26, and page 33, line 19, of the specification.

The rejection of claim 31 under 35 U.S.C. 112, first paragraph, set forth in the office action mailed on Nov. 17, 2004, paragraph 9, has been mooted by the cancellation of claim 31 set forth in the amendment filed on Apr. 12, 2005.

The rejections under 35 U.S.C. 103(a) of claims 1, 4-6, 9, 29, and 31 over Japanese patent 06-348055 (JP'055) combined with US 6,077,635 (Okado) or combined with Okado and the other cited references; of claims 1, 2, 4, 6-10, and 29-31 over Japanese Patent 2000-112180 (JP'180) combined with Okado or combined with Okado and the other cited references; and of claims 1, 2, 9-11, and 29-31 over JP'180 combined with US 6,326,115 B1 (Nakanishi),

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set forth in the office action mailed on Nov. 17, 2004, paragraphs 11, 12, 14-18, and 20 respectively, have been withdrawn in response to the amendment filed on Apr. 12, 2005, to claim 1, adding the limitation of now-cancelled claim 3 that the toner composition further satisfies the charge relationship now recited in instant claim 1.

The prior art of record does not teach or suggest a toner having the spherical degree and ratio of the charge control agent M/T recited in instant claim 1 and satisfying the charge relationship now recited in instant claim 1. In particular, for the reasons discussed in paragraph 11 of the last office, a person having ordinary skill in the art would have reasonably concluded that JP'055 teaches toners having a charge controlling agent on the surface of the toners that satisfy the ratio M/T recited in instant claim 1. However, JP'055 does not teach or suggest that the toners satisfy the charge relationship recited in instant claim 1. Furthermore, there is not enough information on the present record for a person having ordinary skill in the art to reasonably determine that the JP'055 toners satisfy the charge relationship recited in instant claim 1. Moreover, as noted by applicants in the reply filed on Aug. 24, 2004, page 24, lines 4-7, the "compositional limitations [recited in the claims] are insufficient by themselves to meet

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the other limitations of the claims." The instant specification shows that toners that meet the compositional limitations recited in instant claim 1, namely having a ratio M/T within the range of 10 to 1000, do not necessarily satisfy the charge relationship recited in instant claim 1. See the instant specification, Table 2 at pages 77-78, examples 1-5 and 8-14. Thus, it is not reasonable to presume that toner compositions disclosed in JP'055 satisfy the charge relationship recited in instant claim 1.

The rejection of claims 1, 2, 9-11, and 29-31 under the judicially created doctrine of obviousness-type double patenting over claims 1-10 of copending Application No. 10/392,894 (Application'894) in view of Nakanishi, and of claims 4 and 6 over claims 1-10 of Application'894 in view of Nakanishi and the other cited references, set forth in the office action mailed on Nov. 17, 2004, paragraphs 21-23, respectively, have been withdrawn in response to the amendment filed on Apr. 12, 2005, to claim 1 described supra. The reference claims of Application'894 do not require that the toner compositions covered by the reference claims satisfy the charge relationship recited in instant claim 1. Nor, in light of the showing in the instant specification described above, is it reasonable to presume that toner compositions recited in reference claims 1

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and 3 of Application'894 satisfy the charge quantity recited in instant claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD  
May 4, 2005

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